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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,862	11/03/2003	Johannes Antonius Walta	EP&C 16.504A	5130
26304	7590	06/02/2005	EXAMINER	
KATTEN MUCHIN ROSENMAN LLP			CHORBAJI, MONZER R	
575 MADISON AVENUE			ART UNIT	
NEW YORK, NY 10022-2585			PAPER NUMBER	

1744

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/699,862

Applicant(s)

WALTA, JOHANNES ANTONIUS

Examiner

MONZER R. CHORBAJI

Art Unit

1744

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/03/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This general action is in response to the continuation application filed on 11/03/2003

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 6-8 and 11-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Pfeifer (U.S.P.N. 5,738,824).

With respect to claims 6 and 11, the Pfeifer reference, which is in the art of sterilizing endoscope, teaches a rack (figure 1, 10) in which an endoscope is accommodated (figure 1, 26, 25 and 20) and a connection block (figure 1, 18) that is in communication with the passages of the endoscope (figure 1, 18 and 19) such that no portion of the endoscope being within the connection block. Further, the Pfeifer reference teaches that the connection block is fixed in the rack (figure 1, 10 and 18) and

Art Unit: 1744

that flexible tubes to passages of the endoscope connect the connection block (figure 1, 19, 22, 20 and 18).

With respect to claims 7-8 and 12-13, the Pfeifer reference discloses a rack (figure 1, 10) with handles (figure 1, 12, where the rack can be carried from the ends of horizontal frame 12) and with means for fixing the end of the endoscope (figure 1, 20, 24, 16 and col.8, lines 16-25), which is placed in the rack (figure 1, 10).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 4-5 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pfeifer (U.S.P.N. 5,738,824) in view of Parker et al (U.S.P.N. 5,425,815).

With respect to claims 4 and 9, the Pfeifer reference discloses a system for treating used endoscopes (col.1, lines 8-10) including the following: a rack (figure 1, 10) with an endoscope therein (figure 1, 26, 25 and 20), a fixed connection block (figure 1,

Art Unit: 1744

18) being connected to passages of an endoscope (figure 1, 26, 25 and 20) by flexible tubes (figure 1, 19) such that no portion of the endoscope being within the connection block, the fixed connection is in the rack (figure 1, 18), a treatment device (col.10, line 3) for subjecting the endoscope to various specific treatments having a counter-connection block (figure 3, 41) connected to the rack's connection block (figure 3, 41 and 10) and flexible tubes to passages of the endoscope connect the connection block (figure 1, 19, 22, 20 and 18). However, with respect to claims 4 and 9, the Pfeifer reference fails to disclose multiple treatment devices with different kinds of treatments such that each treatment device not having an enclosing wall in common with the other devices. The Parker reference, which is in the art of disinfecting endoscopes, discloses plurality of treatment devices (figure 3 and 10-12) such that each device can be run differently and that depending on the type of the endoscope being treated, the cycles parameters can be modified (col.4, lines 16-25). This statement means a treatment cycle in device 3 can be operated differently than a treatment cycles in device 11. Clearly, the Parker reference teaches plurality of different treatment devices. With regard to the devices as not having common walls, the Parker reference discloses a device made up of multiple integral compartments, which cleans, disinfects and dries endoscopes. Also, the Pfeifer reference teaches of a single device such that the washing, the disinfecting and the drying steps are all performed in one apparatus. Parker and Pfeifer devices are made up of integral parts or elements such that each part performs a step in the process of disinfecting endoscopes. Thus, to separate a structure, which is made up of various elements into individual separate devices is unpatentable. The mere fact that a given

Art Unit: 1744

structure is integral does not preclude its consisting of various elements. See Nerwin V. Erlichman, 168 USPQ 177, 179 (PTO Bd. Of Int. 1969). As a result, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of the Pfeifer reference by including treatment cycles with different parameters as taught by the Parker reference in order to accommodate the system for different types of endoscopes with different treatment needs (col.4, lines 20-25).

With respect to claims 5 and 10, the Pfeifer reference discloses carrier tray (figure 4, 61, 62 and col.10, lines 2-6) for transporting the endoscope.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Moser (U.S.P.N. 5,279,799) reference and the Biermaier (U.S.P.N. 5,288,467) reference disclose the concepts of having a rack with a connection-block with flexible connection tubes for counter-connecting to the interior surfaces of endoscopes. The Nethercutt (U.S.P.N. 4,262,800) reference discloses holders for endoscopes and the Williams et al (U.S.P.N. 4,915,913) reference discloses a sterilizer container with handles.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MONZER R. CHORBAJI whose telephone number is (571) 272-1271. The examiner can normally be reached on M-F 6:30-3:00.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN KIM can be reached on (571) 272-1142. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1744

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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05/31/2005

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